

REMARKS

I. Status of the Claims

With the amendments herein, claims 1-2, 4-5, 7-9, 27, 36, 51, 53, 55, 57, 60-62, 64, 66, and 73 are currently pending. Without prejudice or disclaimer, claims 32, 37, and 80-84 are canceled, and claims 1, 36, and 55 are amended herein. Support for the amendments can be found in the specification and claims as-filed. Accordingly, no new matter has been added.

Applicants note for the record that the Examiner's summary of the claimed invention on pages 2-3 of the final Office Action is an incomplete summary of the scope of Applicants' claims. Without detailing the deficiencies of the Examiner's summary, Applicants reserve the right to argue broader claim scope where appropriate.

II. Interview Summaries

Applicants thank the Examiner for the telephonic interviews of July 6 and August 17, 2009, with Applicants' representatives. Applicants agree with the substance of the interview summaries mailed July 10 and August 25, 2009, in that Applicants' representatives discussed multiple possible options for advancing prosecution and no agreement was reached.

III. Rejection under 35 U.S.C. § 103

The Examiner maintains the rejection of claims 1-2, 4-5, 7-9, 27, 32, 36-37, 51, 53, 55, 57, 60-62, 64, 66, and 73 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Nos. 6,635,702 (the '702 patent) and 5,580,494 (the '494 patent), as well as WO

2002/096385 (WO '385) and WO 2002/096377 (WO '377) for the reasons set forth in the final Office Action at pages 2-6. Specifically, the Examiner states that "[t]he declaration filed under 37 C.F.R. 1.132 filed 3/18/09 is insufficient to overcome the rejection" for various reasons and/or questions listed therein. Final Office Action at page 5. Applicants continue to disagree and traverse the rejection for the reasons of record, as well as the following reasons, because the Examiner has not made a *prima facie* case of obviousness. See, e.g., Response filed March 18, 2009, at pages 2-5.

For example, Applicants disagree with the Examiner statement that the '702 patent "suggests" adding calcium carbonate (see Office Action of Dec. 18, 2008, at page 7) because the '702 patent actually states that such insoluble materials, such as calcium carbonate, "require stabilization." See the '702 patent, col. 8, lines 56-60. Further, while the Examiner appears to be making an "obvious to try" argument (see Office Action of Dec. 18, 2008, at page 8), such a rationale fails in the instant case because there are not, as required, a "finite number of identified, predictable potential solutions." See Response filed March 18, 2009, at page 3. Rather, there is a wide variety of solutions to hairstyle problems where the results are not predictable. See *id.* Indeed, WO '377 recognized such unpredictability but stating that it arrived at its "surprising and unexpected" solution "by carefully selecting" the ingredients therein. See *id.*

In addition to the reasons of record, Applicants first note that claims 32 and 37 have been canceled herein. Additionally, Applicants present further reasons for traversing the rejection by addressing the Examiner's questions and concerns from the current final Office Action below.

(1) The Examiner alleges that the declaration "results are not clear" because, in the comparison testing, the inventive compositions employed "0.2% of calcium carbonate" but claim 1 "recites at least 10% by weight of calcium carbonate." Final Office Action at page 5. Applicants note that claim 1 recites, in relevant part, "at least one water-insoluble solid mineral particle chosen from clays and particles comprising at least 10% by weight of calcium carbonate." Claim 1 (emphasis added). Thus, at least 10% by weight of calcium carbonate, to which the Examiner refers, is the percentage of calcium carbonate in the particles themselves, not the percent of calcium carbonate in composition as a whole. Applicants clarify for the record that the calcium carbonate particles, used in the testing of the Declaration filed March 18, 2009 ("Declaration 1"), were substantially pure calcium carbonate (i.e., about 100% CaCO_3) and thus, the particles themselves contained "at least 10% by weight of calcium carbonate" as claimed.

(2) Regarding the crosslinked copolymer used in the testing of Declaration 1, the Examiner inquires as to "[w]hat is the amount of ethyl acrylate and what is the amount of methacrylic acid tested in the declaration?" Final Office Action at page 5. Applicants clarify that Acrylates Crosspolymer (30%) AQUA SF1 from NOVEON, employed in Declaration 1 contains about 56% by weight of ethyl acrylate and about 44% by weight of methacrylic acid. Accordingly, the crosspolymer used in the testing of the Declaration 1 falls within the scope of claim 1 which recites, in relevant part, "at least one crosslinked copolymer comprising at least one methacrylic acid unit and at least one $\text{C}_1\text{-C}_4$ alkyl acrylate unit." See claim 1.

(3) Regarding the results presented in Declaration 1, the Examiner states that "[i]n table 2, the comparative composition has better suppleness when the hair is wet, where as [sic] when the hair was dry the inventive composition has better results." Final Office Action at page 6. Applicants agree with the Examiner's observations and note that such results support Applicants' position that there is lack of predictability and thus, no *prima facie* case of obviousness. See, e.g., Response filed March 18, 2009, at page 4-5.

(4) Further, *without providing any rationale*, the Examiner alleges that "[t]he test results for particle being clay did not show unexpected results." Final Office Action at page 6. However, Applicants note that, in dry hair, the clay-containing inventive Composition C showed significantly better softness and texture compared with comparative Composition A. See Declaration 1 at pages 4-5. Moreover, Composition C received better numerical values than the inventive Composition A in all but one test in both wet and dry hair. Such results, even if not statistically significant, can be informative. See *Abbott Laboratories vs. Sandoz Inc.*, 544 F.3d 1341 (Fed. Cir. 2008), where Judge Newman did not require a showing of statistically significant differences in comparative testing; numerical differences were enough. Thus, as the Declarant testified, the results, *taken as a whole*, show marked improvement of the cosmetic properties in the hair treated with inventive Compositions B and C. See Declaration 1 at page 5. Finally, as mentioned above, Declaration 1 was not submitted to rebut a *prima facie* case of obviousness. Rather, the data was submitted to support Applicants' position that there is no *prima facie* case of obviousness due to a lack of predictability. See, e.g., Response filed March 18, 2009, at page 4-5.

(5) Without explaining why, the Examiner asserts that "[t]he showing in the declaration is not commensurate with the scope of the claims." Final Office Action at page 6. However, as mentioned above, the data was submitted to support Applicants' position that there is no *prima facie* case of obviousness because of lack of predictability. See, e.g., Response filed March 18, 2009, at pages 4-5. Thus, whether testing is commensurate in scope is irrelevant to the issue of predictability. Nonetheless, Applicants understand that by filing a second Declaration under 37 U.S.C. § 1.132 using the elected cationic polymer, the showing will be considered commensurate in scope. See Interview Summary mailed August 25, 2009. As discussed below, such a Declaration is filed herewith.

(6) Finally, the Examiner states that the "[e]lected cationic polymer is **polyethylenimine**" and notes that "[t]here [are] no test results . . . [where] the cationic polymer is polyethylene imine." See Final Office Action at pages 5-6 (emphasis original). Applicants clarify for the record that Declaration 1 was submitted under the apparently mistaken understanding that the recommended testing should focus on a comparison of mica-TiO₂ as taught by the '702 patent with particles of calcium carbonate and particles of clay, as claimed. Accordingly, Applicants attempted to replicate, as faithful as possible, Example 5 of the '702 patent which contained mica-TiO₂ but which contained cationic polymers other than the elected species.

In response to the Examiner's concerns, and in an effort to advance prosecution, Applicants submit herewith a Declaration under 37 C.F.R. § 1.132 of Samira Khenniche dated November 13, 2009 ("Declaration 2"). Declaration 2 demonstrates the difference in softness, smoothness, suppleness in both wet and dry hair between comparative

Composition A and inventive Compositions B and C. *See* Declaration 2 at ¶¶ 9-10 and Tables 2-3. As shown in Table 1, Composition A and Compositions B and C were identical except that Composition A (comparative) contains mica-TiO₂ while Composition B (inventive) contains calcium carbonate and Composition C (inventive) contains clay, as the water-insoluble solid mineral particles according to the present claims. *See id* at Table 1. The calcium carbonate particles are substantially pure (i.e., about 100%) calcium carbonate. Declaration 2 filed herewith is similar to Declaration 1, except that each of Compositions A-C contains the elected cationic polymer, polyethyleneimine. *See id*.

The cosmetic properties of the hair were evaluated by six experts. *See* Declaration 2 at ¶ 8. The wet hair was evaluated for softness, smoothness, and suppleness. *See id*. After the locks were dried, the hair was again evaluated for softness, smoothness, and suppleness. *See id*. The results were ranked from 0-5 with zero representing "not good" and five representing "excellent." *See id*. The overall results show statistical and/or numerical differences between comparative Composition A and inventive Compositions B and C. *See id*. at Tables 2 and 3. For example, the smoothness of both wet and dried hair is statistically different for the comparison of Composition A (comparative) and Composition B (inventive) as well as for the comparison of Composition A (comparative) and Composition C (inventive). *See id*. As discussed above, even where the results are not statistically significant numerical differences can be informative. *See Abbott Laboratories vs. Sandoz Inc.*, 544 F.3d 1341 (Fed. Cir. 2008), where Judge Newman did not require a showing of statistically significant differences in comparative testing; numerical differences were enough.

Thus, from the results as a whole, the Declarant testifies that there is a marked improvement of the cosmetic properties in the hair treated with inventive Composition B and inventive Composition C. See Declaration 2 at Tables 2 and 3, and ¶¶ 9.

One of skill in the art would not have been able to predict those improved cosmetic properties, particularly in view of the teachings identified above of WO '377. Hence, the Examiner has failed to make a *prima facie* case of obviousness. Accordingly, for at least the reasons listed above, Applicants respectfully request withdrawal of the rejection.

III. Conclusion

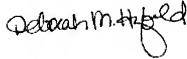
In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

If the Examiner believes a phone call would be useful in resolving the outstanding issues, she is respectfully invited to contact the undersigned at 202-408-4368.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.



Dated: November 13, 2009

By: _____
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Attachments: Declaration under 37 C.F.R. § 1.132 of Samira Khenniche, dated
November 13, 2009.